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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,359	02/17/2004	William Kenneth Ryan	KenRyan	9928
7590 DONAVON LEE FAVRE 250 58TH STREET N. APT 1009 ST. PETERSBURG, FL 33710			EXAMINER PHAN, TUANKHANH D	
			ART UNIT 2163	PAPER NUMBER
			MAIL DATE 07/17/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/780,359

Applicant(s)

RYAN, WILLIAM KENNETH

Examiner

TUAN-KHANH PHAN

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The amendment, filed 4/17/2008, has been entered and acknowledge by the Examiner. Claims 1-32 are pending.

Response to Arguments

Applicant's arguments, filed 4/17/2008, have been fully considered but they are not persuasive.

Issue I. The Applicant argues that Broadhurst is directed to registering one associated domain name in combination with a plurality of different top level domain names. Claims 1 and 32 of the present invention have been amended to recite registering a plurality of associated domain names in combination with a single top level domain name. The present invention, as claimed in the amended claims, is directed to registering a plurality of associated domain names in a single associated directory. The single associated directory is associated with a registered domain name and allows additional related or same domain names to be registered, thus expanding the capacity of the Internet to put additional domain names in its physical memories.

Response I. The Examiner would like to assert that Broadhurst teaches a plurality of sub-directories, each subdirectory containing a listings such as **records of sub-domain names** (col. 1, lines 59-65; col. 2, lines 35-40), wherein a sub-directory of names can be kept under one domain name in a single directory. Thus, Applicant's argument is not persuasive.

Issue II. The Applicant argues that neither Broadhurst or Kelly or the combination thereof remotely suggest the association of a directory with each registered domain name and the addition of a plurality of associated domain names to each associated directory. Kelly is directed to using the Internet for telephone communications.

Response II. As pointed out in the Response I above, a sub-directory of names can be made under one domain name in a single directory. Therefore, the argument made by the Applicant is not persuasive.

Issue III. The Applicant argues that Neither Broadhurst or Quigley or the combination thereof remotely suggest the association of a directory with each registered domain name and the addition of a plurality of associated domain names to each associated directory.

Response III. The Examiner would like to state that Quigley discloses (p. 16, line 1) different conventional domain names with the combination of a directory taught by Broadhurst (col. 1, lines 59-65; col. 2, lines 35-40) to deal with "cyberpirates" or "cybersquatters" of domain names, such that additional domain names are allowed under the same directory. Thus, Applicant's argument is not persuasive.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claim 23, the phrase "not normally used" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-7, 9 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Broadhurst (US Pat. 6,560,634).

Regarding claims 1 and 32, Broadhurst teaches in a national or other top-level (i.e. **a generic top level domain name [gTLD; .com] or country code top level domain [ccTLD; .us], list of 50 countries**, Figure 5B; col. 7, lines 14-25) Internet registry system, having a memory for Internet names to facilitate computer communicating with other computer using TCP/IP, which allows nationals to register a different domain name resulting in a plurality of different registered domain names (i.e. **registration is performed upon a user selects a specified domain name to be registered**, col. 6, lines 50-55) in an internet directory, each name having an IP address having a single top level domain name, the improvement characterized by:

a) an associated directory under each of a plurality of the different domain names (i.e. **a data system maintaining registration records of domain names**

for various domain names, col. 2, lines 35-45; col. 2, lines 50-53) in addition to and not replacing (i.e. **a domain name is not available for registration if there already exist the domain names - they cannot be replaced**, col. 6, lines 20-26) the plurality of different registered domain names (col. 6, lines 20-26),

b) the numeric Internet Protocol (IP) address of the associated directory (i.e. **associated domain names contain associated numerical address [IP]**, col. 2, lines 6-9; col. 3, lines 54-60) being separate from the numeric Internet Protocol address of a corresponding different domain name (i.e. **information regarding the domain name is not being compared, but only the domain name when check for its availability**, col. 3, lines 54-60), the numeric IP address of the corresponding different domain name remaining unchanged (i.e. **information regarding the domain name remains unchanged when check for a domain name's availability**, col. 6, lines 20-26), and

c) a collection of more than one associated domain names and information concerning the owner or owners of each of the associated domain names contained in each associated directory, the associated domain names in each associated directory having the same top level domain name as the associated directory in an internet memory (i.e. **indication of a contact person for particular domain name includes owner(s)**, col. 3, lines 56-60; **Whois information could include identity of domain name owner(s)**, col. 4, lines 30-33).

Regarding claim 2, Broadhurst teaches the Internet system of claim 1 wherein each of a plurality of associated directories optionally includes the corresponding domain name of an owner or owners of the corresponding different domain name and includes an IP address of each of the secondary domain owners (col. 3, lines 55-60; col. 4, lines 29-33).

Regarding claim 3, Broadhurst teaches the Internet system of claim 1 wherein each of a plurality of associated directories (col. 2, line 43-45, **records for an associated domain name**) contains more than one associated mnemonic domain names identical to the each of a plurality of registered mnemonic domain names (i.e. **a domain name may used as a type of mnemonic characters**, col. 1, lines 26-32; col. 2, lines 45-47).

Regarding claim 4, Broadhurst teaches the Internet system of claim 1 further characterized by a separate listing of associated domain names with an IP address (i.e. **database contains records associating with IP address**; col. 2, lines 5-9).

Regarding claim 6, Broadhurst teaches the Internet system of claim 1 further characterized by the associated domain names listed by post office address (col. 2, lines 15-17 & 20-29).

Regarding claim 7, Broadhurst teaches the Internet system of claim 1 further characterized by the associated domain names listed by telephone area code and telephone number (col. 2, lines 15-17 & 20-29).

Regarding claim 9, Broadhurst teaches the internet system of claim 1 further characterized by a plurality of multi tiered directories containing names (i.e. **registration**

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records of multi-domain names of associated domains is a multi-record of directories, col. 2, lines 35-40 & 43-49) in combination with information concerning the owner or owners of names contained in each of the directories, the names in combination with information being in addition to and not replacing mnemonic domain names (i.e. **a domain name may be used as a type of mnemonic characters**, col. 1, lines 26-32; col. 2, lines 45-47).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 8, 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadhurst in view of Paltridge (Internet Domain Names: Allocation Policies, OCDE/GD(907)207).

Regarding claim 5, Broadhurst teaches the Internet system of claim 1 further characterized by the associated domain names but lacks the ranking of selection order. In the same field of endeavor, Paltridge discloses the ranking domain queries (p. 70, Table 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ranking order of frequency taught by Paltridge into the associated records of domain names taught by Broadhurst to tabulate a table of domain names registered per capita for data analysis.

Regarding claim 8, see discussion of claims 1 and 5 above, Paltridge further teaches the Internet system of claim 1 further characterized by the associated domain names listed by type of business (i.e. **additional set of gTLDs indicates general type of business a domain name is registered for**, p. 27, ¶ 3).

Regarding claim 10, Broadhurst teaches the Internet system of claim 9 wherein each of a plurality of multi tiered directories contain the name, address, emails, and phone number but lacks type of business.

However, in the same field of domain name registration associated records listing, Paltridge teaches type of business (i.e. **showing identifiers of specific professions or business activities**, p. 55, lines 9-24) an owner or owners of each name contained in each of the directories.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate type of business of domain names taught by Paltridge into directory records taught by Broadhurst to envisage for people to use DNS locate a service as readily as the "yellow pages" (p. 55, lines 10-14)

Regarding claim 11, Broadhurst teaches in an Internet registry system of claim 1 which allows nationals to register primary domain names [as admitted by the applicant, primary is a domain name registered by a national authority] (col. 7, lines 14-25; col. 6, lines 50-55), the improvement characterized by:

a) Broadhurst teaches a plurality of sub-directories, each subdirectory containing a listings (i.e. **records of sub-domains**, col. 1, lines 59-65; col. 2, lines 35-40); while Broadhurst teaches sub-domain from top domain, Broadhurst does not explicitly disclose second level domain of a plurality of associated second level domain names (SLDs) corresponding to a corresponding SLD of a registered domain name, each of the plurality of listings constituting an associated sub-directory. However, in the same field of endeavor of domain

name registration and associated records, Paltridge teaches associated records of the second level domain corresponding with registered domain names (p. 11, ¶ 1, lines 8-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made incorporated the second level domain taught by Paltridge into the associated records and sub-domains of Broadhurst construct a solid hierarchy of domain levels.

b) a collection of names and information concerning each associated SLD contained in each associated sub-directory (see discussion of part a above), the IP address of each sub-directory being separate from the IP address of the corresponding domain name, the IP address of each corresponding primary domain name remaining unchanged (i.e. **a collection of names and IP addresses remains unchanged since listing them is apart from checking for availability**, col. 3, lines 55-60; col. 4, lines 29-33).

Regarding claim 12, see discussion of claim 11, Broadhurst teaches the Internet system wherein each of a plurality of associated sub-directories includes more than one associated domain name of secondary name owners of associated domain name and an IP address of each of the secondary domain name owners (i.e. **indication of a contact person for particular domain name includes owner(s)**, col. 3, lines 56-60; **Whois information could include identity of domain name owner(s)**, col. 4, lines 30-33).

Regarding claim 13, see discussion of claim 11 above, Paltridge further teaches the Internet system wherein each of a plurality of associated sub-directories contains

more than one SLD identical to the SLD of corresponding domain name (p. 11, ¶ 2, lines 4-14).

Regarding claim 14, see the discussion of claim 11, Paltridge further teaches the system characterized by a separate listing of associated second level domain names with an IP address (p. 11, ¶ 1, lines 8-14).

Regarding claim 15, see the discussion of claim 11, Paltridge teaches the system further characterized by the associated second level domain names ranked in the order of frequency of selection (p. 70, Table 20).

Regarding claim 16, see the discussion of claim 11 above, Broadhurst further teaches system characterized by the associated second level domain names listed by post office address (col. 2, lines 15-17 & 20-29).

Regarding claim 17, see the discussion of claim 11 characterized by the associated second level domain names listed by telephone area code and telephone number (Broadhurst, col. 2, lines 15-17 & 20-29).

Regarding claim 18, see the discussion of claim 11, Paltridge further teaches the Internet system characterized by the associated second level domain names listed by type of business (p. 27, ¶ 3).

Regarding claim 19, see the discussion of claim 11, Paltridge further teaches the system wherein each of a plurality of associated sub-directories includes an associated sub-sub-directory (p. 11, ¶ 2, lines 4-14).

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadhurst in view of Kelly (US Pat. 6,347,085)

Regarding claim 20, Broadhurst teaches an Internet registration system claim 1 having a basic Internet domain name structure (i.e. register for a domain name, col. 6, lines 50-56) characterized by: a) a register for any name an applicant wishes to register without changing the basic Internet domain name structure (col. 6, lines 50-56), but lacks b) one or more registers for qualifiers consist essentially of one or more descriptive terms and, which qualifiers in combination with the name distinguish the registration from all previous registrations of the same name, whereby multiple uses of identical names to identify different resources can be employed.

However, in the same field of endeavor of domain names registration, Kelly teaches lacks b) one or more registers for qualifiers, which qualifiers in combination with the name distinguish the registration from all previous registrations of the same name, whereby multiple uses of identical names to identify different resources can be employed (i.e. representing different related names could register for distinguish domain name registration, col. 9, lines 36-55; col. 13, lines 1-21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made could have combine the different domain names under a common names with different keys taught by Kelly with Internet domain name register structure of Broadhurst to resolve a domain name or sub-domain names to a network protocol address of a gTLD or ccTLD.

Regarding claim 21, see discussion of the claim 20 above, Broadhurst further teaches characterized by the registered name being a name that the registrant has a legal right to use (i.e. Apple has the legal right to use the name "apple" for different domain or sub-domain names, col. 4, lines 50-60).

Regarding claim 22, see discussion of claim 20 above, Kelly further teaches the registration system characterized by the registers being arranged in a tree structure (col. 9, lines 44-46), each name-tree structure containing several instances of non-unique entries, each entry further qualified by additional attributes (Figure 4).

Claims 23-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadhurst in view of Quigley (Bulletin July/August 1998 Internet Update – New Domain Names and Dispute Resolution Rules)

Regarding claim 23, Broadhurst teach an Internet registry system of claim 1 containing conventional domain names in a directory, but lacks each conventional domain name having a top level domain component and a second level domain component, the improvement characterized by a) the addition of one or more duplicate added second level domain names and b) the addition of one or more characters and/or ordinals anywhere in each added second level domain name to create new domain names, all different, the added characters not normally used in domain names and not forming conventional names, and without changing the original domain name.

However, in the same field of domain name registration, Quigley teaches each conventional domain name having a top level domain component and a second level domain component (page 14, lines 20-32), the improvement characterized by a) the

addition of one or more duplicate added second level domain names (page 14, lines 20-32) and b) the addition of one or more characters and/or ordinals anywhere in each added second level domain name to create new domain names, all different, the added characters not forming conventional names, and without changing the original domain name (page 14, lines 20-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made could have put the additional of character into new domain names but not changing the original or conventional names taught by Quigley into conventional domain names in a directory of Broadhurst to deal with "cyberpirates" or "cybersquatters" of domain names (p. 16, line 1).

Regarding claim 24, see discussion of claim 23 above, Broadhurst further teaches the system wherein the new domain names are contained in a directory wherein the improvement is further characterized by the directory containing sufficient information about each new added domain name to aid a user in the selection of the desired new added domain name (col. 50-55).

Regarding claim 25, Broadhurst further teaches wherein the display of the view of the characters is suppressed (i.e. not all domains supporting the Whois-queries, thus the information is hidden, col. 6, 35-37).

Regarding claims 26-27, according to claim 23 Quigley further teaches wherein the characters comprise one character and one or more ordinal (page 14, lines 20-32).

Regarding claim 28 in an Internet registry system of claim 1 having a plurality of different registered domain names, the improvement characterized by a registry component produced by:

Broadhurst does not teach a) a resource to indicate the existence of a non-unique domain name,

Broadhurst teaches b) a stop in an automatic translation of a domain name to a numeric IP address, and

c) a spawning of a separate process to present a sub-directory of identical domain names plus additional distinguishing information from which a user can make a selection (**records of sub-domains**, col. 1, lines 59-65; col. 2, lines 35-40), the non-unique domain names being in addition to and not replacing the plurality of different registered domain names, which different registered domain names retain their original IP address (col. 6, lines 20-26).

In the same field of domain name registration, Quigley teaches a resource to indicate the existence of a non-unique domain names (i.e. **alpha-one.com and alpha-1.com are non-unique domain names**, p. 14, lines 20-29).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporate the non-unique domain names taught by Quigley into domain records and directories of Broadhurst to prevent barring registration of similar names (Quigley, p. 14, lines 20-29).

Regarding claim 29 and 31, see the discussion of claim 28, Quigley further teaches characterized by the domain name plus one or more qualifiers (i.e. qualifier

could be any add extra character to register a non-unique domain name and foster a creative spirit among the trademark owners, p. 14, lines 20-29).

Regarding claim 30, see the discussion of claim 29 above, Quigley teaches the system of claim 29 characterized by the one or more qualifiers comprise characters and/or ordinals (p. 14, lines 20-29).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **TUAN-KHANH PHAN** whose telephone number is (571)270-3047. The examiner can normally be reached on 4/5/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TKP

/Hung T Vy/

Primary Examiner, Art Unit 2163